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U.S. District Court DISTRICT OF ARIZONA (Phoenix Division) CIVIL DOCKET FOR CASE #: 2:11-cv-00333-MEA Internal Use Only

VIP Products LLC v. Bradley Caldwell Incorporated et al

Assigned to: Magistrate Judge Mark E Aspey

Cause: 15:1125 Trademark Infringement (Lanham Act)

Date Filed: 02/18/2011 Jury Demand: Plaintiff

Nature of Suit: 840 Trademark Jurisdiction: Federal Question

Plaintiff

VIP Products LLC

an Arizona limited liability company

Trademark # 1,558,243

represented by Andrew L Pringle

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UNITED STATES DISTRICT COURT	
DISTRICT OF ARIZONA	
VIP Products, LLC, an Arizona limited	Case No.
liability company,	
Plaintiff,	COMPLAINT
. V.	(Federal Trademark Infringement;
Bradley Caldwell, Inc. a Pennsylvania	Lanham Act Unfair Competition;
L.L.C., a Texas limited liability company,	Arizona Common Law Unfair Competition)
Defendants.	Trial By Jury Demanded
	I
Plaintiff, VIP Products, LLC ("Plaintiff" or "VIP"), by and through its undersigned	
19 counsel, Mariscal, Weeks, McIntyre & Friedlander, P.A., for its complaint against	
Defendants Bradley Caldwell, Inc. and Lone Star Pet Supply, GP, L.L.C. (collectively,	
21 "Defendants"), hereby alleges and states as follows:	
I.	
THE PARTIES	
1. VIP is an Arizona limited liability company with its principal place of business	
at 16515 S. 40 th Street, Suite 121, Phoenix, Arizona 85048.	
	David G. Bray (#014346) david.bray@mwmf.com Timothy J. Thomason (#009869) tim.thomason@mwmf.com Andrew L. Pringle (#004674) larry.pringle@mwmf.com MARISCAL, WEEKS, McINTYRE & FRIEDLANDER, P.A. 2901 North Central Avenue, Suite 200 Phoenix, Arizona 85012-2705 Phone: (602) 285-5000 Fax: (602) 285-5100 Attorneys for Plaintiff UNITED STATES D DISTRICT OF VIP Products, LLC, an Arizona limited liability company, Plaintiff, v. Bradley Caldwell, Inc. a Pennsylvania corporation, Lone Star Pet Supply GP, L.L.C., a Texas limited liability company, Defendants. Plaintiff, VIP Products, LLC ("Plaintiff counsel, Mariscal, Weeks, McIntyre & Fr Defendants Bradley Caldwell, Inc. and Lone "Defendants"), hereby alleges and states as followed the product of the product o

2. Upon information and belief, Defendant Bradley Caldwell, Inc. ("Bradley Caldwell") is a Pennsylvania corporation with its principal place of business at 200 Kiwanis Blvd. Hazleton, PA 18202. Upon information and belief, Bradley Caldwell is a large national distributor of pet toys among other products.

3. Upon information and belief, Defendant Lone Star Pet Supply, GP, L.L.C. ("Lone Star Pet") is a Texas limited liability company with its principal place of business at 17414 Triton Dr., Schertz, TX 78154. Upon information and belief, Lone Star Pet is a large national wholesaler of a variety of products, including pet toys.

II.

JURISDICTION AND VENUE

- 4. This Court has personal jurisdiction over Defendants, and each of them, because each conducts business in the State of Arizona, has caused injury to VIP in Arizona, and has caused events to occur in Arizona out of which the causes of action alleged herein arise.
- 5. The Court has subject matter jurisdiction over the claims under the Lanham Act (including Lanham Act §§ 32 and 43(a), 15 U.S.C. §§ 1114 and 1125(a)) pursuant to 15 U.S.C. §§ 1121(a) and 1116 and 28 U.S.C. §§ 1331 and 1338(a). The Court has supplemental jurisdiction over VIP's claims under Arizona law pursuant to 28 U.S.C. § 1367(a) and also has jurisdiction over the unfair competition claim pursuant to 28 U.S.C. § 1338(b).
- 6. Venue is proper in this district under 28 U.S.C. § 1391(b) and (c) as the claim arose in this district and the Defendants are subject to personal jurisdiction in this state.

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FACTS COMMON TO ALL CLAIMS

7. VIP is engaged primarily in the business of designing, manufacturing, and marketing dog toys.

- 8. VIP sells several lines of dog toys, including the "TUFFY" line (durable sewn/soft toys), the "MIGHTY" line (durable toys made of a different material than the TUFFY line), the "SILLY SQUEAKERS" line (vinyl squeaky novelty dog toys) and the TUFFY branded "RUGGED RUBBER" co-branded line (hard rubber dog toys).
- 9. In March of 2008 VIP acquired by assignment all rights, title and interest in the federally registered TUFFY® trademark, U.S. Reg. No. 1,558,243, for pet toys in International Class 28. This mark has been registered with the United States Patent and Trademark Office since September 26, 1989.
- 10. Since the date of assignment, VIP has used the federally registered TUFFY® mark in commerce continually in the United States in connection with pet toys.
- 11. Defendants, and each of them, without the consent of VIP, are using in commerce VIP's registered TUFFY® mark, or reproductions, counterfeits, copies or colorable imitations of VIP's registered TUFFY® mark, in connection with the sale, offering for sale, distribution or adverting of pet toys that are not VIP's TUFFY® dog toys but rather are competing pet toys produced and distributed by VIP's competitors, including pet toys manufactured by The Kong Company, LLC ("Kong"). Such use is likely to cause confusion or mistake or to deceive and constitutes infringement of VIP's registered TUFFY® mark for which Defendants, and each of them, are liable pursuant to 15 U.S.C. § 1114(1)(a).
- 12. Some or all of the violations, unlawful uses and unlawful actions alleged herein involved the use of a counterfeit mark, within the meaning of 15 U.S.C. § 1116(d)(1)(B) and § 1127, and/or counterfeit goods.
- 13. VIP has not granted a license to, or otherwise authorized, Kong or others to use the TUFFY® mark on or in connection with any products that are not marketed by VIP.
- 14. An example of Defendant Lone Star Pet's Internet advertising of competing toys using a reproduction, counterfeit, copy or colorable imitation of VIP's registered TUFFY® mark is attached as Exhibit A.

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- An example of Defendant Bradley Caldwell advertising competing pet toys 15. using a reproduction, counterfeit, copy or colorable imitation of VIP's registered TUFFY® mark is attached as Exhibit B.
- 16. All of the acts and events alleged herein occurred in interstate commerce and affected interstate commerce.
- Upon information and belief, Defendants' unauthorized use of the TUFFY® 17. mark, or reproductions, counterfeits, copies or colorable imitations thereof, is intended to trade off of the goodwill of VIP's TUFFY® trademark.
- Defendants' unauthorized use of VIP's TUFFY® mark, or any reproduction, 18. counterfeit, copy or colorable imitation of VIP's TUFFY® mark, in the manner described above:
 - has caused, is causing and is likely to cause confusion or mistake, or to (a) deceive customers and potential customers of the parties, as to the origin, sponsorship, or approval of Defendants' products, services and commercial activity, or as to some affiliation, connection, or association of Defendants (or Defendants' products or services) with VIP or VIP's products;
 - is false and misleading and a misrepresentation of fact, made in (b) commercial advertising or promotion, of the nature, characteristics and qualities of Defendants' products, services and commercial activities and/or of VIP's TUFFY® line of dog toys.
 - (c) enables Defendants to trade off and receive the benefit of the goodwill VIP has built up at great labor and expense over many years, and to gain acceptance for Defendants' products and services not solely on their own merits, but on the reputation and goodwill of VIP's TUFFY® mark, and their products and services;

unjustly enriches Defendants; and

(d)

(e) unlawfully removes from Plaintiff the ability to control the nature and quality of products and services provided under VIP's TUFFY® mark and places the goodwill and valuable reputation of VIP in the hands of Defendants, over which VIP has no control.

- 19. VIP has been damaged and continues to be damaged by Defendants' unauthorized use of the mark and trade name TUFFY®, or of reproductions, counterfeits, copies or colorable imitations thereof, in the manner described above. Defendants, and each of them, have profited and been unjustly enriched by such use. At a minimum, VIP is entitled to recover Defendants' profits and damages sustained by VIP, enhanced according to the circumstances of the case, together with the costs of this action pursuant to 15 U.S.C. § 1117(a).
- 20. Unless the acts of Defendants described herein are restrained by this Court, they will continue to cause irreparable injury to VIP and to the public, for which there is no adequate remedy at law. At a minimum, VIP is entitled, pursuant to 15 U.S.C. § 1116(a), to an injunction preventing Defendants, each of them and all persons in active concert or participation with them, from continuing the unlawful acts alleged herein and from doing any act or thing likely to mislead, confuse or deceive others as to VIP's sponsorship, connection or approval of Defendants' products, services or commercial activity or as to the origin, nature, characteristics and qualities of Defendants' products or services; directing them to perform corrective advertising to undo the damage to VIP's registered mark that their unlawful acts have caused; and providing such other equitable relief as would be reasonable to prevent further violations of VIP's rights.
- 21. As to those unlawful acts that involved the use of a counterfeit mark or designation, VIP is at a minimum entitled to recover statutory damages pursuant to 15 U.S.C.

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25 26 § 1117(c)(1) and, because Defendants' actions were willful, VIP is entitled to enhanced statutory damages pursuant to 15 U.S.C. § 1117(c)(2).

This is also an exceptional case that warrants an award of attorney's fees 22. pursuant to 15 U.S.C. § 1117(a).

V.

CLAIMS FOR RELIEF

COUNT I

FEDERAL TRADEMARK INFRINGEMENT

(Lanham Act § 32, 15 U.S. C. § 1114(1)(a))

- VIP realleges and incorporates the allegations set forth in paragraphs 1 through 23. 22 above.
- The acts of Defendants complained of herein constitute use in commerce, 24. without the consent of VIP, of reproductions, copies, counterfeits or colorable imitations of VIP's federally registered TUFFY® mark in connection with the sale, offering for sale, distribution or advertising of goods and services in violation of 15 U.S.C. § 1114(1)(a).
- Defendants' use of the mark TUFFY®, or reproductions, counterfeits, copies, or 25. colorable imitations thereof, on or in connection with goods and services in the manner described above is likely to cause confusion, to cause mistake, or to deceive.
- On information and belief, Defendants' acts complained of herein have been 26. deliberate, willful, and intentional, with full knowledge and in conscious disregard of VIP's rights in their marks and with intent to trade on VIP's goodwill in its mark. On information and belief, as to the counterfeit marks and designations, Defendants intentionally used the infringing marks or designations, knowing that such mark or designation was counterfeit, in connection with the sale, offer for sale or distribution of goods or services.
- As to those unlawful acts that involved the use of counterfeit marks or 27. designations, VIP is entitled to recover three times VIP's damages or three times Defendants'

profits, whichever is greater, together with reasonable attorney's fees and prejudgment interest on the amount awarded from the date of service of this complaint, pursuant to 15 U.S.C. § 1117(b).

28. As a result of the foregoing actions of Defendants, Defendants have been unjustly enriched and VIP has been injured and damaged and is entitled to monetary and other relief as alleged above. In addition, unless Defendants are enjoined as alleged above, VIP will continue to suffer irreparable injury and damage for which there is no adequate remedy at law.

COUNT II

FEDERAL UNFAIR COMPETITION, FALSE DESIGNATION OF ORIGIN (Lanham Act § 43(a)(1)(A-B), 15 U.S. C. § 1125(a)(1) (A-B)

- 29. VIP realleges and incorporates the allegations set forth in paragraphs 1 through 28 herein.
- 30. Defendants' unauthorized use of names, words, terms, symbols or marks confusingly similar to VIP's registered TUFFY® mark (alone or in combination), false designations of origin and false or misleading descriptions or representations of fact, in commerce in connection with goods or services, falsely indicates that Defendants and their products and services are connected with, sponsored by, approved by, affiliated or associated with, or related to VIP.
- 31. Defendants' unauthorized use of names, words, terms, symbols or marks confusingly similar to VIP's registered TUFFY® mark (alone or in combination), false designations of origin and false or misleading descriptions or representations of fact, in commerce in connection with goods or services, misrepresented the nature, qualities and characteristics of Defendants' goods, services or commercial activity, and/or VIP's products, in commercial advertising or promotion.

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39. enriched.

Defendants' unauthorized use of VIP's mark and related actions have caused, 32. and is likely to continue to cause, confusion, mistake, or to deceive and/or deception as to the origin, sponsorship and affiliation of the goods offered for sale by Defendants and their goods and services.

- Defendants' unauthorized use and actions allow Defendants to receive the 33. benefit of VIP's goodwill, which VIP has established at great labor and expense, and further allows Defendants to expand their business and sales, based not on their own qualities, but on the reputation and goodwill of VIP.
- The acts of Defendants complained of herein constitute unfair competition and 34. false designation of origin in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).
- On information and belief, Defendants' acts complained of herein have been 35. deliberate, willful, and intentional, with full knowledge and in conscious disregard of VIP's rights its mark and with intent to trade off VIP's goodwill in.
- As a result of Defendants' actions alleged herein, Defendants have been 36. unjustly enriched, and VIP has been injured and damaged and is entitled to monetary and other relief as alleged above. In addition, unless Defendants are enjoined as alleged above, VIP will continue to suffer irreparable injury and damage for which there is no adequate remedy at law.

COUNT III

ARIZONA UNFAIR COMPETITION

- VIP realleges and incorporates the allegations set forth in paragraphs 1 through 37. 36 herein.
 - Defendants' actions constitute unfair competition under Arizona common law. 38.
- By their actions, Defendants have damaged VIP and have been unjustly

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Defendants have caused, and unless enjoined will continue to cause, irreparable 40. harm to VIP for which there is no adequate remedy at law.

VI.

PUNITIVE DAMAGES ALLEGATION

Upon information and belief, Defendants have acted with an evil mind and 41. conducted themselves in a sufficiently aggravated and outrageous manner so as to be liable for punitive damages under Arizona common law.

VII.

PRAYER FOR RELIEF

WHEREFORE, VIP prays that:

- Judgment be entered for VIP and against Defendants, and each of them, on all 1. of its claims.
- Defendants, their agents, servants, employees, attorneys, and all others in active 2. concert or participation with any of them, be enjoyed and retrained, during the pendency of this action, and permanently thereafter, from:
 - using the name or mark "TUFFY"® or any reproduction, counterfeit, (a) copy or colorable imitation thereof in connection with or in relation to goods that do not originate with VIP;
 - doing any other act or thing likely to confuse, mislead, or deceive others (b) into believing that Defendants, or their products (other than goods originating with VIP) or services, come from, or are connected with, sponsored by, or approved by VIP;
 - doing anything or act in commercial advertising or promotion that would (c) misrepresent the nature, characteristics and qualities of Defendants' products or services or VIP's products.

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- - 3. An accounting be directed to determine Defendants' profits resulting from their activities and that such profits be paid to VIP and increased as the Court finds to be just under the circumstances of this case.
 - 4. Defendants, and each of them, be required to pay to Plaintiff:
 - (a) in accordance with Section 35 of the Lanham Act, 15 U.S.C. § 1117(a) and (b), an award of treble VIP's actual damages and Defendants' profits, together with profits resulting from sales by Defendants relating to their aforesaid trademark infringement and unfair competition;
 - (b) in accordance with Section 35(c) of the Lanham Act, 15 U.S.C. § 1117(c) statutory damages for Defendants' use of a counterfeit mark;
 - (c) VIP's attorneys' fees and costs of this action pursuant to 15 U.S.C. § 1117;
 - (d) Prejudgment interest pursuant to 15 U.S.C. § 1117(b).
 - 5. Defendants, in accordance with Section 34(a) of the Lanham Act, 15 U.S.C. § 1116(a), be required to file with the Court, and serve upon VIP, within thirty (30) days after the entry and service of Defendants of an injunction, a report in writing and under oath, setting forth in detail the manner and form in which Defendants have complied with the terms of such injunction.
 - 6. VIP recovers such other relief as the Court may deem appropriate.

VIII.

JURY DEMAND

VIP demands a trial by jury on all claims so triable.

RESPECTFULLY SUBMITTED this 18th day of February, 2011.

MARISCAL, WEEKS, McINTYRE & FRIEDLANDER, P.A.

By: s/David G. Bray

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